

REMARKS

This paper is responsive to an Office Action dated September 20, 2004. Prior to this response claims 1-17 were pending. After amending claims 1-2, 4-5, 8-10, 12-13, 15 and 17, and canceling claims 7 and 16, claims 1-6, 8-15, and 17 remain pending.

In Section 3 of the Office Action, objections have been made to the specification for the use hyperlinks and trademarks. In response, the hyperlinks have been deleted and the symbol for trademark (TM) has been appended to the trademarked terms.

In Section 6 of the Office Action, objections have been made to claims 1, 4, 5, 8, 9, 10, 12, 13, and 17. In response, claim 8 has been amended to depend from claim 1. Claims 1-2, 4, 5, 9, 10, 12, 13, and 17 have been amended to remove a comma.

In Section 8 of the Office Action, claims 7, 9, and 16 have been rejected under 35 U.S.C. 112, first paragraph. In response, claims 7 and 16 have been cancelled, and claim 9 amended to delete the mention of Java and VB.

In Section 10 of the Office Action, claims 1, 4, 5, 7, 9, 10, 12, 13, 15, 16, and 17 have been rejected under 35 U.S.C. 112, second paragraph. Claims 7, 9, and 16 have been rejected for the trademark terminology. As noted above, claims 7 and 16 have been cancelled, and claim 9 amended to delete the mention of Java and VB.

Claims 10, 13, 15, and 17 have been rejected for the lack of antecedent basis for the phrase "file directory". In response, these claims have been amended to recite a -folder directory--.

Claim 17 has been rejected for the lack of antecedent basis for the phrase "the folder" in lines 10 and 18. In response, the Applicant notes that antecedent basis for the phrase can be found in line 7 of the claim.

Claims 7, 9, and 16 have also been rejected as vague and unclear. As noted above, claims 7 and 16 have been cancelled, and claim 9 amended to delete the mention of Java and VB.

In Section 12 of the Office Action claims 1 and 10 have been rejected under 35 U.S.C. 102(b) as being anticipated by Tokuda et al. ("Tokuda"; US 6,038,541). The Office Action states that Tokuda discloses a process for supplying folder with scripts; selecting a folder; processing a document; and adding the processed document to the selected folder. This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Tokuda describes a process that analyzes a document, and based upon an analysis of document content, sorts the document. Once sorted, the document is sent along different workflow paths. Referring to Fig. 1, sorter 104 performs a sorting or classification operation on an accepted document. For example, the sorting can be based upon a keyword search (col. 5, ln. 2-10). Documents 120, 122, 124, and 126 are examples of the kinds of documents that can be differentiated. The sorting process associated with documents 120 through 126 is explained at col. 2, ln. 51 through col. 6., ln. 34. For example, when a document has been determined to be a multimedia document 120, the sorter refers to a

business table that correlates document type to business department, and sends the document to first unit business 114. The different types of documents 120-126 are sent to units (business groups) 112 through 118, respectively (col. 5, ln. 25-28).

Thus, Tokuda describes a process that accepts a number of document types, sorts the documents according type, and sends them along a workflow path in response to the classification steps. Tokuda differentiates between documents on the basis of document content. The invention of claims 1 and 10 does not sort between document types. Rather, the claimed invention process begins with a single document. Folders are set up, and a different job processing script assigned to each folder. The single document is processed in accordance with a script in response to the selection of a folder. Alternately stated, the claimed invention describes a method for pre-establishing a set of job processes that can easily be selected by merely assigned a job to a folder. Tokuda describes a method for parallel processing different types of documents, after the initial step of sorting.

Tokuda does not describe the steps of supplying a plurality of folder with scripts, selecting a folder, and processing a document as a result. Tokuda cannot, for example, direct that a multimedia document 120 be processed along the second unit 114 workflow path. Unit 114 can only process a network-associated document 122. Thus, Tokuda cannot select a job script folder. Since Tokuda does not explicitly describe the steps of the inventions of claims 1 and 10, he cannot anticipate. The Applicant respectfully requests that the rejection be removed.

In Section 14 of the Office Action claims 2-9 and 11-17 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to

Tokuda, in view of Matsuo et al. ("Matsuo"; US 6,775,729) and further in view of SAMS, Teach Yourself Javascript in 24 Hours ("SAMS"). With respect to claims 2, 11, 13, and 17, the Office Action acknowledges that Tokuda does not disclose an MFP or the recited processing operations, but states that Matsuo describes an MFP, and that it would have been obvious "to use Matsuo's MFP in Tokuda because this would provide Tokuda with control functions for scanner, fax, printer and photocopier." This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

Matsuo, at col. 1, ln. 35-67, describes an MFP that performs functions such as printing, scanning, fax, and photocopier functions. Specifically, the invention is described as device control programs, for maintaining the functions of the various MFP engines, which are executed in the event of a job interruption. As described at col. 6, ln. 32 through col. 7, ln. 49, controller 101 is connected to, and controls the scanner and print engines (102, 103, 104, and 105). SAMS describes JavaScript.

With respect to the first *prima facie* requirement to support a case of obviousness, there appears to be no motivation to look to the Matsuo and SAMS references, to make a modification to Tokuda. As noted above, Tokuda describes a process that accepts a variety of document types and sorts them into different workflow paths. It does not seem readily apparent that a person skilled in the art would be motivated to modify a parallel workflow process with an MFP controller. Matsuo's mechanism for controlling various MFP processing engines appears to give no suggestion as to how Tokuda's sorting process can be modified. Alternately stated, Matsuo does not address the subject of workflow.

The declaration of Andrew Ferlitsch is enclosed as Attachment A to support the Applicant's position that a *prima facie* case of obviousness has not been made. In his declaration, one of Mr. Ferlitsch's primary assertions is that there is little similarity between the claimed invention method of processing a document in response to assigning it to a script folder, and Tokuda's sorting process. Further, Mr. Ferlitsch notes that even if the Matsuo and Tokuda references are combined, there is still no suggestion of a method that assigns scripts to folders, and processes a document in response to selecting a folder.

Alternately stated, the Office Action has not demonstrated that the modification of the cited the prior art references points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis. Even if Matsuo could be combined with Tokuda, there is no expectation from the combination that various job processing scripts can be established, and that a job be processed by assigning the job to the folders, since neither reference addresses this subject matter.

With respect to the third *prima facie* obviousness requirement, the references even when combined do not disclose all the elements of the claimed invention. With respect to claims 1, 9, 10, and 17, neither Matsuo nor Tokuda describe the creation of folders with different job processing scripts, and the processing of a job in response to assigning a document to a particular folder. As noted above, Tokuda describes the sorting of documents into different workflow paths, and Matsuo an MFP engine controller. Neither does the addition of SAMS' description of JavaScript address the claimed invention script folder limitations.

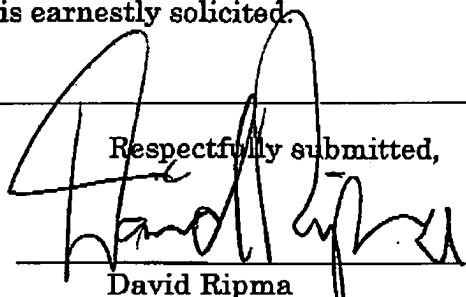
Therefore, the combination of Matsuo, SAMS, and Tokuda does not explicitly describe all the limitations of the base claims 1, 9, 10, and 17. Neither does the combination of references suggest a modification that makes claims 1, 9, 10, and 17 obvious. Claims 2-7, dependent from claim 1, and claims 11-15, dependent from claim 10, enjoy the same distinctions from the cited prior art as the base claims, and the Applicant requests that the rejections be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Date:

10/29/04

Respectfully submitted,

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